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Telephone No.From: Brian D. Martin, EsquireDirect Dial: 213-617-5415Re: Transmittal of Response to Restriction Requirement*Jedso 12:05 p.m.***MESSAGE:** Please see attached.**Certificate of Transmission under 37 CFR 1.8**

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Brian D. Martin
Brian D. Martin, Esquire

Response to Restriction RequirementApplicants: Kelvin Tsugio Okamoto et al.Title: GOLF BALLS INCORPORATING PEPTIZERS AND
METHOD OF MANUFACTURESerial No: 10/662,626Filed: September 15, 2003Examiner: Racann GordonGroup Art Unit: 3711Our Docket No.: 0EKM-106840Date Faxed: 09/20/04Client: Taylor MadeDate Due: 10/01/04Atty/Sec.: Martin/Kemp

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PATENT
0EKM-106840

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/662,626 Confirmation No. 9769
Applicants : Kelvin Tsugio Okamoto et al.
Filed : September 15, 2003
TC/A.U. : 3711
Examiner : Raeann Gordon

Docket No. : 0EKM-106840
Customer No. : 30764

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VIA FACSIMILE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Non-Final Office Action mailed September 1, 2004. On page 2 of the Office Action, the Examiner required a restriction to one of the following inventions:

- I. Claims 1-[43], drawn to a golf ball [including a composition] . . . ;
- II. Claims [44]-50, drawn to a method [for manufacturing a golf ball] . . . "

In the Office Action, it appears that the Examiner mistakenly included claim 44 in Group I instead of Group II.

In response to the restriction requirement, Applicants elect the invention of Group I, drawn to a golf ball including a composition, with traverse. In the restriction requirement, the Examiner alleges that the application includes two distinct inventions. Specifically, the Examiner identifies Group I, claims 1-43, which are drawn to a golf ball

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including a composition, as allegedly distinct from Group II, claims 44-50, drawn to a method for manufacturing a golf ball. The Examiner alleges that the golf ball including a composition of Group I can be made using a process that is materially different from that claimed in claim 44. Applicants respectfully disagree.

Group II includes independent claim 44 and its dependent claims 45-50.

Claim 44 recites a method for manufacturing a golf ball that includes providing the components of a composition, preparing the composition, and forming the composition into the golf ball. Any allegedly different process for manufacturing the golf ball including the composition of claim 1 would fall within the scope of claim 44, and thus, it cannot be considered materially different from the invention recited in claim 1. The claimed product, *i.e.*, the golf ball having the composition, cannot be made by a method other than that recited in claim 44, *i.e.*, a method of manufacturing the golf ball having the composition.

Moreover, Applicants respectfully request the Examiner to reconsider the restriction requirement between Group I and Group II for the reason that there is no additional burden to search and examine the two groups of claims together. Specifically, the claims of Group II describe a process for manufacturing a golf ball including the composition that is the subject of claim 1. The search and examination can proceed on the basis of claim 1. As such, there is no additional burden on the part of the U.S. Patent and Trademark Office to examine claims 1-43 together with claims 44-50. According to MPEP § 803, if the search and examination of patent claims can be made without serious burden, the Examiner must examine the patent claims on their merits, even though the application allegedly includes claims to independent or distinct inventions.

In addition to the above rule, the MPEP also provides for rejoinder of claims subject to a restriction requirement. According to MPEP § 821.04, non-elected process claims can be rejoined after an elected product claims is allowed if the process claims depend upon or otherwise include all of the limitations of the allowable product claim. This rule applies here. Therefore, claims 1-43 should be examined together with claims 44-50.

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For the above reasons, Applicants respectfully request the withdrawal of the restriction requirement between Groups I and II.

Now, this application should be in condition for a favorable substantive examination. Early issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

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